

Remarks/Arguments

Favorable consideration of this application is respectfully requested.

The present application is a continuation application of, and claims priority under 35 U.S.C. § 120, to U.S. application serial no. 10/023,707, filed December 21, 2001, which is currently pending.

Upon entry of the foregoing Amendment, Claims 1-6, 9-15, 18-21, and 22-23 are pending. Applicant has canceled Claims 7, 8, 17, and 18 without prejudice or disclaimer; amended Claims 1, 3-6, 9, 10, 12-15, and 18-20 to further clarify the claims; and added Claims 22-23 to better represent the claimed invention. No new matter has been added.

The present Preliminary Amendment is made in light of an Office Action issued in the parent application (U.S. Application Serial No. 10/023,707) mailed October 8, 2003. That Office Action objects to the title of the invention as not descriptive; objects to the Abstract; rejects Claims 1-6, 9-15, and 18-21 under 35 U.S.C. § 103(a) as unpatentable over Hube, et al. (U.S. Patent No. 5,229,814, herein “Hube”); and objects to Claims 7, 8, 16, and 17 as dependent upon a rejected base claim, but indicates that Claims 7, 8, 16, and 17 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

In regard to the objection to the title of the invention, the title is amended to be more clearly indicative of the claimed invention. Accordingly, Applicant respectfully requests withdrawal of the objection.

In regard to the objection to the Abstract of the Disclosure, the Abstract is amended as suggested in the Office Action. Accordingly, Applicant respectfully requests withdrawal of the objection.

In regard to the rejection of Claims 1-6, 9-15, and 18-21 under 35 U.S.C. § 103(a), that rejection is traversed.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be demonstrated. First, the cited art to Hube must teach or suggest each and every element recited in the claims.<sup>1</sup> Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference in a manner resulting in the claimed invention.<sup>2</sup> Third, a reasonable probability of success must exist.<sup>3</sup>

Claim 1 recites an image forming apparatus including, among other things, a memory configured to store setting information including at least a size of a substitute recording medium for each user. The Office Action asserts that “element 56 (Fig. 2) of Hube et al is the storage means for storing setting and/or reading means for reading, respectively, information including at least a size of substitute recording medium.”<sup>4</sup> However, Hube does not teach or suggest at least a memory configured to store setting information including at least a size of a substitute recording medium for each user. In Hube, the data regarding a substitute recording medium is “entered by the site administrator or operator at any convenient time using UI 52.”<sup>5</sup> “For example, the data may be initially entered at the start of operation each day and periodically updated during the day as the availability of the different stock characteristics changes with system operation.”<sup>6</sup> Nowhere does Hube teach or disclose

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<sup>1</sup> See MPEP § 2143.

<sup>2</sup> See *id.*

<sup>3</sup> See *id.*

<sup>4</sup> Office Action of October 8, 2003, in U.S. 10/023/707, page 4, lines 13-15.

<sup>5</sup> Hube, col. 7, lines 17-18.

<sup>6</sup> Col. 7, lines 18-22.

at least a memory configured to store setting information including a size of a substitute recording medium for each user.

In view of the failure of Hube to teach or suggest all the features of Claim 1, Applicant respectfully submits that the rejection of Claim 1 under 35 U.S.C. § 103(a) should be withdrawn. Independent Claims 10, 19, and 20, although of different statutory class or of different scope, include recitations similar to those in Claim 1 discussed above. Claims 2-6, 9, 11-15, 18, and 21 depend on Claims 1, 10, or 20. For at least the reasons given above with respect to Claim 1, Applicant respectfully requests that the rejection of Claims 2-6, 9-15, and 18-21 under 35 U.S.C. § 102(e) be withdrawn. Accordingly, Applicant respectfully request that Claims 1-6, 11-15, 18, and 21 be allowed.

In regard to the objection to Claims 7, 8, 16, and 17, Applicant has canceled these claims, making the objection thereto moot.

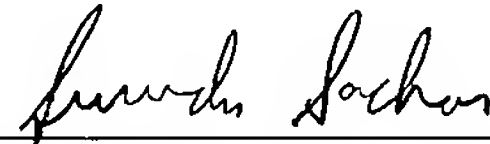
New Claims 22 and 23, although of different statutory class or of different scope, include recitations similar to those in Claim 1 discussed above. For at least the reasons given above with respect to Claim 1, Applicant respectfully requests that Claims 22 and 23 also be allowed.

Preliminary Amendment  
Attorney Docket No. 246853US-2 DIV  
Inv: NOZOMI SAWADA

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Applicants respectfully request favorable consideration and prompt allowance of the application.

Respectfully submitted,

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